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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,017	02/07/2001	Handong Wu	NETAP009	5629

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SILICON VALLEY IP GROUP P.C.
P.O. BOX 721120
SAN JOSE, CA 95172-1120

EXAMINER

NGUYEN, QUANG N

ART UNIT PAPER NUMBER

2141

DATE MAILED: 08/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/779,017

Applicant(s)

WU, HANDONG

Examiner

Quang N. Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-18, 20-23 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-18, 20-23 and 25-28 is/are rejected.
- 7) ☒ Claim(s) 29-30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Detail Action

1. This Office Action is in response to the Amendment filed on 06/18/2004. Claims 1, 16, 25 and 26 have been amended. Claims 13, 19 and 24 have been canceled. Claims 29-30 have been added as new claims. Claims 1-12, 14-18, 20-23 and 25-30 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 3-12, 14, 16-18, 21-23, 25-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bandera et al. (US 6,332,127), herein after referred as Bandera, in view of Capek et al. (US 6,094,677), herein after referred as Capek, and further in view of Dodrill et al. (US 6,738,803), herein after referred as Dodrill.**

4. As to claim 1, Bandera teaches a method for providing advertising to a mobile device, comprising:

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receiving a request for content from the handheld computer (*a Web server 24 receiving a Web page request from a mobile Web client 21*) (Fig. 2, C7: L9-10);

associating an advertisement with the request for content (*Web server generates the requested Web page with the selected advertising objects included there within*);

sending the requested content to the handheld computer for display on the screen of the computer (*the requested Web page is then served/transmitted to the mobile Web client*) (Bandera, C7: L28-31); and

sending the associated advertisement to the handheld computer for playing over an audio output device of the handheld computer (*the selected advertising objects within the requested Web page 26, which may include text files, audio files, video files, image files and the like, can be sent from the Web server 26 and played/displayed at the mobile Web client 21*) (Bandera, C5: L22-26 and C7: L28-31).

However, Bandera does not explicitly teach the audible advertisement is played simultaneously with the display of the requested content on the computer and sending a visual warning when an audio channel is turned off.

In a related art, Capek teaches a system and method for providing advertisement insertions, wherein the insertion maybe data in virtually any suitable format (*such as text, graphics, animation, motion video, sound, etc.*) associated/customized to the user profile and/or requested program material (*i.e., requested content*) and the insertion maybe played simultaneously to the user with the display of the requested program material (Capek, C7: L48-65 and C12: L56-63).

In another related art, Dodrill teaches a proxy browser providing voice enabled web application audio control for mobile devices, wherein the proxy browser includes IP and PSTN network interface cards each are able to perform basic telephony functions, such as detect an on-hook or off-hook condition (*i.e., detecting when the audio channel of handheld computer is turned off*), detect incoming phone call or message, notify the corresponding user device accordingly by flashing an alert message (*i.e., flashing/sending a visual/alert message when the audio is off*) and send/receive audio signals (Dodrill, C11: L22-32).

Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to combine the teachings of Bandera, Capek and Dodrill to simultaneously play the audible advertisement with the display of the requested content and to send a visual warning when an audio channel of the handheld computer is turned off since such methods were conventionally employed in the art to provide information (*providing user with advertisement insertions customized/associated with the user or the requested content*) during relays in retrieving requested program material in order to improve the interactive experience of an interactive system such as the WWW (Capek, C4: L28-51); and to notify the user accordingly about the incoming message when the audio function of the device is turned off (*e.g., flashing or vibrating the mobile phone to alert/warn user that there is an incoming call when the sound is turned off*) so user can take appropriate action.

5. As to claim 3, Bandera-Capek-Dodrill teaches the method of claim 1, wherein the network is the Internet (*the mobile Web client 21 is in communication with the Web server 24 via a computer network, such as the Internet 25 in Fig. 2*) and receiving a request for content comprises receiving an HTTP request (Bandera, Fig. 2, C1: L18-22 and C45-59).

6. As to claim 4, Bandera-Capek-Dodrill teaches the method of claim 3, wherein associating an advertisement with a request for content comprises sending a link to an advertisement server along with the requested content (*the advertising object 32 might contain a hypertext link 36 to an advertising server*) (Bandera, C7: L56-67).

7. As to claim 5, Bandera-Capek-Dodrill teaches the method of claim 4, wherein the requested content is sent from a server hosting a Web site (*i.e., the Web server 24 in Fig. 2*).

8. As to claims 6-7, Bandera-Capek-Dodrill teaches the method of claim 1, wherein the request for content identifies the source as a handheld computer establishing a wireless connection with the network (*based on the user location information obtained via GPS or via a telephone system included in an HTTP header part of the Web page request, the Web server can identify the source as a mobile device such as a PDA, a handheld computer, a "smart" mobile phone, etc., establishing a wireless connection with the network*) (Bandera, C6: L56-67, C7: L1-16).

9. As to claim 8, Bandera-Capek-Dodrill teaches the method of claim 7, wherein sending the associated advertisement comprises sending the advertisement in-band with the requested Web content (*the Web server generates the requested Web page with the selected advertising object included there within to send to the mobile Web client*) (Bandera, C7: L28-31).

10. As to claim 9, Bandera-Capek-Dodrill teaches the method of claim 7, wherein sending the requested content and associated advertisement comprises utilizing a wireless access protocol (*since the mobile Web client communicates with the Web server via a wireless/mobile network, hence, it inherently utilizes a wireless access protocol to send request and receive response from the network*).

11. As to claims 10-11, Bandera-Capek-Dodrill teaches the method of claim 1 further comprising receiving information about the handheld computer requesting content and associating an advertisement with the request for content comprises associating an advertisement based on the information received about the handheld computer (*i.e., the Web server may select an advertising object based on the retrieved mobile Web client location information and time of day the request was received*) (Bandera, C7: L9-26).

12. As to claim 12, Bandera-Capek-Dodrill teaches the method of claim 1, wherein associating an advertisement based on the content requested (Capek, C8: L31-52).

13. As to claim 14, Bandera-Capek-Dodrill teaches the method of claim 1, wherein sending the associated advertisement comprises sending the advertisement in an audio format *(the selected advertising objects within the requested Web page 26, which may include text files, audio files, image/video files and the like, can be sent from the Web server 26 and played/displayed at the mobile Web client 21)* (Bandera, C5: L21-26).

14. Claims 16-18 and 21-23 are corresponding claims of method claims 1, 3, 5 and 9-12; therefore, they are rejected under the same rationale.

15. Claim 25 is a corresponding computer program product claim of method claim 1; therefore, it is rejected under the same rationale.

16. Claims 26 and 28 are corresponding system claims of method claims 1 and 5; therefore, they are rejected under the same rationale.

17. Claims 2, 15, 20 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bandera-Capek-Dodrill, and further in view of Jong (US 6,173,250).

18. As to claims 2 and 15, Bandera-Capek-Dodrill teaches the method of claim 1, but does not explicitly teach that sending the associated advertisement comprises sending the advertisement in a text format that can be converted to speech.

In the related art, Jong teaches an apparatus and method for speech-text-transmit communication over data networks includes speech recognition devices and text to speech conversion devices that translate speech signals input to the terminal to text and text data received from a data network into speech output signals, wherein the receiving terminal receives text data (*i.e., the advertisement in a text format*) and may immediately display the text data and/or translate it into speech output signals using the text to speech conversion device (Jong, Abstract, Fig. 6, C5: L22-33 and C7:L61 – C8:L3).

Therefore, it would have been obvious to one having ordinary skills in the art at the time the invention was made to combine the teachings of Bandera-Capek-Dodrill and Jong to send the advertisement in a text format that can be converted to speech since such methods were conventionally employed in the art to allow the system to transmit the advertisement in a text format at a lower speed and therefore a lower bandwidth since text data packets representing speech are streaming at a lower data rate when compared with voice data packets.

19. Claims 20 and 27 are corresponding claims of method claims 2 and 15; therefore, they are rejected under the same rationale.

Allowable Subject Matter

20. Claims 29-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

21. In the remarks, applicant argued in substance that

(A) Prior Art fails to teach “sending a visual warning when an audio channel of handheld computer is turned off.”

As to point (A), **Dodrill** teaches a proxy browser providing voice enabled web application audio control for mobile devices, wherein the proxy browser includes IP and PSTN network interface cards each are able to perform basic telephony functions, such as detecting an on-hook or off-hook condition (*i.e., detecting when the audio channel of handheld computer is turned off*), detecting incoming phone call or message, notifying the corresponding user device accordingly by flashing an alert message (*i.e., flashing/sending a visual/alert message when the audio is off*) and send/receive audio signals (**Dodrill**, C11: L22-32). Hence, Prior Art does teach “sending a visual warning when an audio channel of handheld computer is turned off.”

22. Applicant's arguments as well as request for reconsideration filed on 06/18/2004 have been fully considered but they are moot in view of the new ground(s) of rejection.

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

24. Further references of interest are cited on Form PTO-892, which is an attachment to this office action.

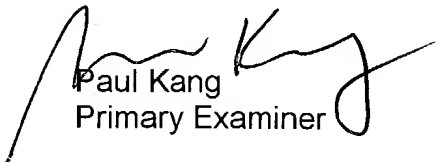
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25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (703) 305-8190.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (703) 305-4003. The fax phone number for the organization is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Quang N. Nguyen
Examiner


Paul Kang
Primary Examiner